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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/609,142	06/30/2000	Luigi Forlai	7704.0001	2446

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EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT PAPER NUMBER

3624

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/609,142

Applicant(s)

FORLAI, LUIGI

Examiner

Narayanswamy Subramanian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-15, 62-72 and 74-96 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-8, 10-15, 62-72 and 74-96 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to Applicants' request for continued examination dated January 31, 2005. Amendments to claims 1, 2, 8, and 62 and cancellation of claims 9 and 73 have been entered. Rejection of claims made under 35 U.S.C. 112, second paragraph are withdrawn by the examiner in view of the persuasive arguments. Claims 1-8, 10-15, 62-72, and 74-96 are currently pending in the application and are subject to restriction/election as discussed below.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1, 62-72, and 74-96 are drawn to methods of making a sale offer over an electronic network system, comprising among others the steps of: randomly generating an offer to purchase a product or service on the electronic network system at an offer price that is substantially equal to a delivery price associated with making the sale offer and less than a market value of the offered product or service, classified in class 705, subclass 37.

II. Claims 2-8 and 10-15, drawn to a method for using an electronic network system to facilitate a transaction between a seller and a buyer, said method comprising among others the steps of: inputting a sale offer parameter for randomly generating at least one sale offer to purchase a product or service at an offer price substantially equal to a discounted value less than a market value of the offered product or service plus a delivery price associated with the transaction, classified in class 705, subclass 37.

3. Inventions I and II are related as sub combinations disclosed as usable together in a single combination. The sub combinations are distinct from each other if they are shown to be

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separately usable. In the instant case, invention I relates to methods of making a sale offer over an electronic network system at an offer price that is substantially equal to a delivery price associated with making the sale offer and less than a market value of the offered product or service, whereas invention II relates to a method for using an electronic network system to facilitate a transaction between a seller and a buyer at an offer price substantially equal to a discounted value less than a market value of the offered product or service plus a delivery price associated with the transaction. See MPEP § 806.05(d). Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

4. Further the inventions in this application contain claims directed to the following patentably distinct species of the claimed inventions:

If invention I is elected then the following claims are directed to different species of the generic feature of randomly displaying an offer as discussed below.

Specie IA1 Claim 63

Specie IA2 Claim 64

Specie IA3 Claims 65-67, 84, 85, 91, 92

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 62, 83 and 90 are generic.

Further if invention I is elected then the following claims are directed to different species of the generic feature of selecting one of a plurality of different types of products or services as discussed below.

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Specie IB1 Claims 70, 86, 87, 93, 94

Specie IB2 Claims 71, 88, 95

Specie IB3 Claims 72, 89, 96

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 69, 83 and 90 are generic.

If invention II is elected then the following claims are directed to different species of the generic feature of randomly generating/displaying an offer as discussed below.

Specie IIA1 Claim 3

Specie IIA2 Claim 4

Specie IIA3 Claims 5, 6

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 2 is generic.

Further if invention II is elected then the following claims are directed to different species of the generic feature of withdrawing at least one randomly generated sale offer as discussed below.

Specie IIB1 Claim 11

Specie IIB2 Claim 12

Specie IIB3 Claim 13

Specie IIB4 Claim 14

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Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 2 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (571) 272-6747. The fax number for Formal or Official faxes and Draft to the Patent Office is (703) 872-9306.

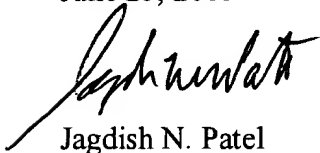
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

N. Subramanian

June 25, 2005

A handwritten signature in black ink, appearing to read 'Jagdish N. Patel', is written over the printed name.

Jagdish N. Patel
Primary Examiner